



GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

EFK

In re application of: Thomas GRAFENAUER

Attorney Docket No. P27123

Application No. : 10/697,560

Mail Stop Amendment
 Group Art Unit : 1774

Filed : October 31, 2003

Examiner : Lawrence Ferguson

For : **PANEL AND PROCESS FOR PRODUCING A PANEL**

Mail Stop Amendment

Commissioner for Patents
 U.S. Patent and Trademark Office
 Customer Service Window, Mail Stop Amendment
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Sir:

Transmitted herewith is a **Response to Restriction Requirement** in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 15	*20	0	x25=	\$	x 50=	\$0.00
Indep. Claims: 3	**3	0	x100=	\$	x200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Extension Fees for __ Month(s)				\$		\$0.00
Total:				\$	Total:	\$0.00

* If less than 20, write 20

** If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

N/A A check in the amount of \$_____ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

Andrew M. Calderon
 Reg. No. 38,093



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Thomas GRAFENAUER

Group Art Unit: 1774

Appln. No. : 10/697,560

Examiner: Ferguson, Lawrence

Filed : October 31, 2003

Confirmation No.: 8411

For : PANEL AND PROCESS FOR PRODUCING A PANEL

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action dated December 8, 2005, Applicant provisionally elects Invention I (claims 1-9) with traverse. Pursuant to 37 CFR § 1.143, Applicant requests reconsideration and withdrawal of the restriction requirement for the reasons discussed below.

If extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 19-0089.

Remarks

Invention I is drawn to a panel and Invention II is drawn to a method of producing a panel. The Examiner asserts that Invention I (defined as claims 1-9) and Invention II (defined as claims 11-15) are unrelated as process of making and product made. The Examiner asserts that the Inventions are patentably distinct because "the product can

be made by the compression and heating of glued extruded woodbased materials.” The Examiner is also of the opinion that restriction is proper because the Inventions are distinct and have different classification. Applicant respectfully disagrees.

It is noted that restriction is only proper when: (1) each invention as claimed is independent or distinct, and (2) there would be a serious burden on the examiner if restriction were not required. See MPEP §§ 803, 808. It is further noted that a process of making and a product made can be shown to be distinct if the product as claimed can be made by another *materially* different process. See MPEP § 806.05(f), upon which the Examiner relies. Applicant submits that the Examiner has not shown that the inventions are independent or distinct, or that there is a serious burden placed on the Examiner in examining all of the claims.

Contrary to the Examiner's assertion, the proffered alternative process is not *materially* different from the claimed process. In fact, the only difference between the Examiner's alternative process and the language of claims 11-15 is the term “extruded”. While claims 11-15 do not expressly recite the use of extruded woodbased materials, they also do not exclude the use of such (*i.e.*, the claims are broad enough to encompass the use of extruded woodbased materials). Therefore, the Examiner has failed provide a reasonable example that shows material differences, and thus has failed to prove distinctness.

Additionally, the present invention relates to a panel made of glued and compressed fiber material, and to a process of producing a panel by the compression and heating of glued woodbased materials. Claim 1 recites, in pertinent part, “A panel, in particular a floor panel, having a support board made of glued and compressed fiber material...”. Claim 11 recites, in pertinent part, “A process for producing a panel ... produced by the compression and heating of glued woodbased materials...” Claim 15 recites, in pertinent part, “A process for producing a support board made of glued and compressed woodbased fiber material...and ... a supply of pressure and heat...” Thus, it can be seen that the process claims recite the compression and heating of glued woodbased materials, as is recited in the product claims.

However, Applicant submits that the restriction requirement set forth by the Examiner omits “an appropriate explanation” as to the existence of a “serious burden” if

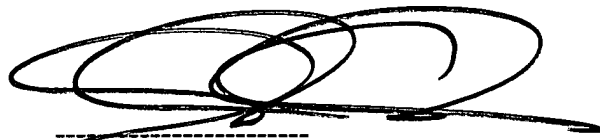
the restriction were not required. (MPEP. § 803) By virtue of the Examiner's requirement and because the claims of the various groups are closely related, it is submitted that there is no serious burden on the Examiner in examining all of the claims together. In fact, Applicant notes, as discussed above, that the process claims recite the compression and heating of glued woodbased materials, as is recited in the product claims, hence substantiating that no serious burden would be placed on the Examiner in examining all of the claims together. Furthermore, Applicant believes that the search for all of the claims includes at least some amount of overlap. Thus, no serious burden would come to bear on the Examiner.

For the above-noted reasons, and consistent with the office policy as set forth in the MPEP, Applicant respectfully requests that the Examiner reconsider the position taken in the above-mentioned Official Action and withdraw the restriction requirement in the present application. Accordingly, the Examiner's restriction requirement is believed to be improper and has been traversed for the reasons set forth above.

Nevertheless, in order to be fully responsive, Applicant has elected with traverse the invention defined by the Examiner as Invention I, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Accordingly, Applicant respectfully requests that the restriction requirement be withdrawn and claims 1-9 and 11-15 be examined on the merits.

Respectfully submitted,
Thomas GRAFENAUER

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a horizontal dashed line underneath it.

Andrew M. Calderon
Reg. No. 38,093

January 5, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191